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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,771	12/28/2001	Ulrich Wernz	WERNZ - 1	9032
25889	7590	05/26/2004	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			MACKEY, JAMES P	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/033,771	Applicant(s) WERNZ, ULRICH	
	Examiner James Mackey	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 3 and 4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 3 and 4 merely recite the manner in which the claimed apparatus structure is intended to be operated during its intended use; such relates only to the intended use of the claimed apparatus, which does not patentably distinguish the apparatus structure and therefore does not further limit the subject matter of the apparatus claims. See *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235.

Applicant argues that “the operation of the features of claims 1 and 3-4 is inherent in the device shown in the drawings, and in light of the specification, is immediately apparent to one of skill in the art”; however, recitations of the “operation of the features” relates only to the intended use of the claimed apparatus, which does not patentably distinguish the apparatus structure.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "briefly" in claim 1 (at line 29) is a relative term which renders the claim indefinite. The term "briefly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be

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reasonably apprised of the scope of the invention. See *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 221 USPQ 568, 574.

Further in claim 1, line 32, “greater time intervals” is indefinite (greater than what?).

Claim 3 depends from itself, and therefore the scope of the claim is indefinite; for purposes of examination, it will be assumed that claim 3 should depend from claim 1.

Claim 3 is further indefinite as to how a “stroke volume” and a “pre-tensioning volume” may “form one common chamber”, since the “volumes” define a quantity, not a structure; moreover, “one common chamber” is indefinite as to exactly where the chamber is located, and how the chamber relates to and cooperates with the other apparatus structural elements.

Claims 3-21 are also indefinite due to their dependence on indefinite claim 1.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3-12, 16, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hettinga in view of Putzler, **for the reasons of record** as described in paragraph 6 of the

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Previous Office Action. Note that the recitations at the end of claim 1 that the piston-cylinder system “is adapted to be briefly filled with or drained with the fluid medium” and “is adapted to receive different amounts of the fluid medium at great time intervals” to thereby “adapt a starting height of the piston-cylinder system (2) to different heights of the molding tool” each relate only to the intended use of the claimed apparatus structure.

7. Claims 13-15 and 17-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Applicant's arguments filed 05 March 2004 have been fully considered but they are not persuasive.

Applicant argues that Hettinga does not teach that the laterally displaceable cylinder can “serve to adjust the height of the die”; however, such relates to the intended use of the claimed apparatus, which does not patentably distinguish the apparatus structure. The displaceable cylinder of Hettinga clearly includes a chamber for hydraulic fluid, and such a chamber (“common chamber” as recited in claim 3) is clearly capable of being filled with different volumes of hydraulic fluid for different time periods, dependent only on the intended use of the apparatus structure. Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. See also *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235.

Applicant argues that Hettinga discloses a horizontal molding machine; however, it would have been obvious to modify Hettinga by providing the molding machine in a

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conventional vertical orientation, as disclosed in Putzler, with the functioning of the apparatus structure being unchanged.

Applicant argues that Putzler does not disclose a laterally displaceable cylinder; however, Putzler does disclose a vertical molding machine having a laterally displaceable clamping pressure plate, and it would have been obvious to a skilled artisan to modify Hettinga by providing the molding machine having a laterally displaceable clamping cylinder in a vertical orientation in view of the teachings of Putzler. Note that one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references, *In re Young et al.*, 159 USPQ 725; moreover, the test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art, *In re McLaughlin*, 170 USPQ 209.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

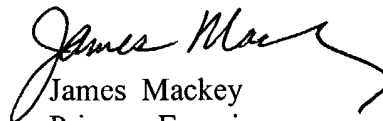
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Mackey
Primary Examiner
Art Unit 1722

5/24/04

jpm
May 24, 2004